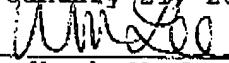


6.26.03

Patent Docket P1003R1C1D1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>In re Application of Robert Akita et al. Serial No.: 09/825,584 Filed: April 4, 2001 For: ISOLATED NUCLEIC ACIDS, VECTORS AND HOST CELLS ENCODING ErbB3 ANTIBODIES (AS AMENDED)</p>	<p>Group Art Unit: 1642 Examiner: Christopher Yaen</p> <p><b>Certificate of Facsimile Transmission Under 37 CFR § 1.8</b> In accordance with CFR § 1.8(d), this correspondence addressed to The Patent and Trademark Office, Washington, DC 20231 is being transmitted to facsimile No. (703) 746-7848.</p> <p>January 21, 2003  Wendy M. Lee</p>
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AMENDMENT UNDER 37 C.F.R. §1.111

Assistant Commissioner of Patents  
Washington, D.C. 20231  
Sir:

Responsive to the Office Action mailed 10/23/02, reconsideration of the present application is requested in view of the following.

Section 112, first paragraph

Claims 34 and 35 are rejected under 35 USC Section 112, first paragraph; the Examiner has requested a statement under 37 CFR §1.808(a)(2) by an attorney of record with respect to the deposit referenced in those claims.

Claims 34 and 35 reference the "8B8 antibody," that can be produced by a hybridoma cell line which was deposited with the ATCC under accession number ATCC HB-12070 on 3/22/96. The deposit is discussed on page 44, line 15, through to line 16 on page 45 of the specification. A copy of the ATCC receipt for the deposit is attached hereto.

The undersigned agent of record hereby states that the deposit of the 8B8 hybridoma/antibody has been made under the terms of the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon

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the granting of a patent.

Applicants submit that the above statement obviates the Section 112, first paragraph rejection of claims 34 and 35. Reconsideration and withdrawal of the rejection is respectfully requested.

Section 101

Claims 37, 41, 45 and 49 are rejected under '35 USC Section 101 on the basis that the invention is directed to non-statutory subject matter. The Examiner contends that the host cell of claims 37, 41, 45, and 49 reads on a product of nature.

Applicants traverse the rejection on the basis that claims 37, 41, 45, and 49 recite "A host cell comprising the isolated nucleic acid" of claims 22, 30, 31 and 32, respectively. The specification explains, page 14, lines 17-24, that the "isolated nucleic acid" is "other than a form or setting in which it is found in nature." Hence, claims 37, 41, 45, and 49, do not read on a product of nature, since the host cell comprises "isolated" nucleic acid.

Reconsideration and withdrawal of the rejection is respectfully requested.

Respectfully submitted,  
GENENTECH, INC.

Date: January 21, 2003

By: 

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PATENT TRADEMARK OFFICE